

## REMARKS/ARGUMENTS

Applicant wishes to thank the Examiner for the telephone interview of 30 August 2005, discussing Applicant's prior response and the Advisory Action dated 24 August 2005. As discussed during the interview, Applicant has amended the independent claim to include the limitation that "substantially the whole of said upper surface will not deform or collapse" under the foot, so as to more clearly distinguish over the *Sacre* reference.

In the Final Office Action, the Examiner stated that Applicant's previous arguments were not considered persuasive. Specifically, the Examiner stated as follows:

In response to Applicant's argument that *Sacre* and *Lin* do not include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., the thickness of the upper layer being uniform thickness) are not stated in the claims.

Accordingly Applicant has amended independent claim 1, from which the other claims depend, to expressly recite that the upper layer of material in the arch portion has a thickness "that is substantially uniform with a thickness of said material in a remainder of said body."

For the reasons explained in Applicant's prior response, both *Sacre* and *Lin* fail to show an insert that meets this requirement. Moreover, *Brown '186* adds nothing that would teach or suggest this element.

Furthermore, Applicant has amended claim 1 to recite that the body of the insert has "sufficient rigidity that substantially the whole of said upper surface will not deform or collapse under said foot."

None of the reference teach or suggest an insert meeting this requirement. Instead, all show devices in which either all or a major portion of the upper surface of the body intentionally does deform and collapse under the user's foot: In *Sacre*, the upper surface in area 30 is designed to "flex up and down when a person lifts and lowers his or her foot"; in *Lin*, the surface collapses to produce a "cushioning" effect; in *Brown '186*, the arch area collapses and changes shape under the foot.

In order to anticipate a claim, the reference must teach every element of the claim (MPEP 2131); in order to establish a *prima facie* case of obviousness, all of the claim limitations must be taught or suggested by the references that are combined (MPEP 2141). As has been

explained above, the references, taken alone or in combination, fail to show an insert in which either (a) the upper layer of material in the arch portion has a thickness that is “substantially uniform with a thickness of said material in a remainder of said body”, or (b) a body “having sufficient rigidity that substantially the whole of said upper surface will not deform or collapse under said foot”. Accordingly, it is respectfully submitted that claim 1 and its dependent claims, as amended herein, are patentably distinct over the cited references.

In addition, Applicant's dependent claims include limitations that further distinguish over the art: Claim 7 recites a depending ridge around a perimeter of a lower surface of the body for penetrating into an insole of a shoe; claim 8 recites that the ridge extends between the lengthwise centerline of the insert and the ribs beneath the arch area; claim 9 recites that the ridge extends a spaced distance behind a metatarsal head area. None of these elements is taught or suggested by the references.

Finally, claim 6 has been amended to replace “thickness” with “height” in order to more clearly define what is meant in the context of the claim, and to avoid confusion with the differing sense in which the term “thickness” is used in other of the claims.

Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and remarks. It is believed that all remaining claims are now in condition for allowance. If there is any matter that can be expedited by consultation with Applicant's attorney, such would be welcome. Applicant's attorney can normally be reached at the telephone number given below.

Signed at Bellingham, County of Whatcom, State of Washington this 30th day of August 2005.

Respectfully submitted,

JOHN WALKER

By

Todd N. Hathaway, Reg. No. 32,991  
119 N. Commercial St. #620  
Bellingham, WA 98225-4437  
(360) 647-1976